

REMARKS

By the above amendment, minor informalities in the previously presented claims have been corrected and new dependent claims 15 and 16 have been presented.

As to the rejection of claims 1, 3, 8 - 9 and 12 under 35 USC 102(e) as being anticipated by Urabe et al (US 6,476,889) and the rejection of claims 2, 10 - 11 and 13 - 14 under 35 USC 103(a) as being unpatentable over Urabe et al, such rejections are traversed insofar as they are applicable to the present claims and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 USC 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 USC §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

As to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie

case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Turning first to claim 1 of this application and as illustrated in Figs. 1 and 2 of the drawings of this application, the present invention is directed to a pixel device, wherein as shown in Fig. 2, in a pixel region formed over a substrate SUB1, a first pixel electrode PX(T) is formed of a light transmissive conductive layer in one optical transmissive region LTA, which is formed by partitioning the pixel region, and a second pixel electrode PX(R) is formed of a non-light transmissive conductive film on the remainder of the partitioned pixel region to form a light reflective region LRA. As shown in Fig. 2, the first pixel electrode is positioned as a lower layer with respect to an insulation film PAS2, and, a hole, as represented by the opening HL2, is formed in the insulation film PAS2, in a region corresponding to the light transmissive region LTA so as to expose the first pixel electrode PX(T). The second pixel electrode PX(R), as shown, is formed at least one of over and in the light reflective region LRA of the insulation film PAS2, as shown in Fig. 2. In accordance with the present invention, as recited in claim 1, and as clearly shown in Fig. 2, at least a portion corresponding to a side wall surface of the hole formed in the insulation film, e.g., the

right-hand side of the opening or hole HL2, as shown in Fig. 2, is arranged in relation to a light shielding film IL, wherein the relationship of the light shielding film to the side wall surface of the hole is clearly illustrated in Fig. 2 of the drawings of this application. As described at page 15, lines 9 - 11 of the specification, the "light shielding layer ILI is formed, as shown in Fig. 1, on the boundary portion between the light transmissive region LTA and the light reflective region LRA", and as indicated as page 15, lines 15 - 17, "the boundary portion of the light transmissive region LTA and the light reflective region LRA corresponds to the side wall surface of the opening portion of the protective film PAS". Applicants submit that the features as recited in claim 1 and the dependent claims are not disclosed or taught by Urabe et al in the sense of 35 USC 102 or 35 USC 103.

Turning to the Examiner's contentions concerning the disclosure of Urabe et al, applicants submit that the Examiner mischaracterizes the disclosure of Urabe et al with respect to the claimed features. Applicants note that the Examiner apparently contends that a light shielding film is represented by the black matrix BM, as illustrated in Fig. 1B and Fig. 3 of Urabe et al. Looking to the attached Sketch, representing Fig. 1B and Fig. 3 of Urabe et al, as annotated, while the Examiner indicates that in Fig. 3, a first pixel electrode formed of a light transmissive conductor layer formed in one optical transmissive region is represented by 115, and a second pixel electrode formed of a non-light transmissive conductive film is formed on the remainder of the partition pixel region and is a reflective region, as represented by 8, it is readily apparent that boundary between the first and second pixel electrodes is delimited in Fig. 3 of Urabe et al by the side wall of the insulation film 114. While the Examiner refers to a hole 112, as shown in Fig. 3, the hole in the insulation film 114 is not "formed in said insulation film in a region corresponding to said light

transmissive region so as to expose said first pixel electrode, as recited in claim 1.

That is, in Fig. 3 of Urabe et al, the hole which is formed in the insulation film 114 and serves as a boundary between the first pixel electrode 115, as acknowledged by the Examiner, and the second pixel electrode 8 which forms a light reflective region, is necessarily, the hole formed at the right side of the insulation film 114 in Fig. 3 of Urabe et al. The hole 112, in Fig. 3 of Urabe et al, has no relation to a side wall surface which exposes the first pixel electrode 115. Furthermore, it is not seen in Fig. 3 of Urabe et al that the pixel electrode 115 is positioned as a lower layer with respect to an insulation film 114, as recited in claim 1. Furthermore, as clearly illustrated in Fig. 3 of Urabe et al, the black matrix BM while having some relation to the hole 112 has no relation to a side wall surface of the hole at the right side of the insulation film 114, which side wall surface serves to expose the first pixel electrode 115. Thus, applicants submit that claim 1 patentably distinguishes over Urabe et al in the sense of 35 USC 102 as well as in the sense of 35 USC 103 and all claims patentably distinguish thereover.

With respect to claim 8, for example, recognizing that the right side of the insulation film 114 in Fig. 3 of Urabe et al serves for exposing the first pixel electrode 115, it is readily apparent that at least the portion corresponding to the side wall surface of the hole is not overlapped with the light shielding film, contended to be the back matrix BM in Fig. 3 of Urabe et al. Applicants further note that claim 2 for example, recites the feature that the first pixel electrode and the second pixel electrode are formed over one of a pair of substrates, as represented by the substrate 2 in Fig. 3 of Urabe et al and that the light shielding film is formed over the one substrate, i.e., the substrate 2, at least at the portion corresponding to the side wall surface of the hole formed in the insulation film, but that the black matrix BM is


formed over the other substrate 1 in Fig. 3 of Urabe et al, and not in relation to the side wall surface of the hole at the right side of the insulation film 114 in Fig. 3 of Urabe et al. With respect to the other dependent claims and the newly added dependent claims, applicants submit that such claims more clearly set forth the structural arrangement as illustrated in Figs. 1 and 2 of the drawings of this application which features are not disclosed or rendered obvious by Urabe et al in the sense of 35 USC 102 or 35 USC 103. Thus, applicants submit that the dependent claims recite additional features not disclosed or taught by Urabe et al, and all claims should be considered allowable thereover.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be in condition for allowance, and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 500.42963X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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